



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,700	03/29/2004	Kazuyuki Kiuchi	Q80631	9045
23373	7590	12/08/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			FIGUEROA, JOHN J	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/810,700

Applicant(s)

KIUCHI ET AL.

Examiner

John J. Figueroa

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The nonstatutory obviousness-type double patenting rejections in items 7-9 on page 4 of the Office Action of June 30, 2006, hereinafter 'OA', is maintained for the reasons set forth and previously made of record in said items of OA.
2. The 35 U.S.C. 102(b) rejection of claims 1-7, 14 and 15 as anticipated by European Patent Application Number (EP) 1,033,393 A2 to Oshima et al., hereinafter 'Oshima', is maintained for the reasons previously made of record in item 11 on page 5 of OA.

### ***Election/Restrictions***

3. Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim, in accordance with the Restriction Requirement in item 1 of OA. Because Applicant did not provide substantive arguments traversing the restriction requirement in the response filed September 29, 2006, hereinafter 'Response', the restriction is thus made FINAL.

***Response to Arguments***

***The Double Patenting Rejections (items 7-9 of OA)***

4. Applicant did not provide substantive arguments in Response with respect to the outstanding nonstatutory obviousness-type double patenting rejections made of record in items 7-9 of OA. Therefore, these double patenting rejections are maintained for the same reasons set forth in said items of OA.

***The 35 U.S.C. 102 Rejection over Oshima (item 11 of OA)***

5. Applicant's arguments in Response with respect to the 35 U.S.C. 102(b) rejection of claims 1-7, 14 and 15 as anticipated by Oshima have been fully considered but are deemed unpersuasive.

Applicant's principal argument concerning the instant claims as not anticipated by Ohshima due to the reference not disclosing all the claim elements because Oshima "does not disclose that the pressure-sensitive adhesive layer containing heat-expandable microspheres and the substrate are peelable from each other by heating ... [and that] the adhesive sheet of Oshima is peeled from an adherend as a whole" is misguided. (See, page 4, first full paragraph of Response.)

Examiner respectfully draws Applicant's attention to Figure 2 on page 11 of Oshima. In Figure 2, Oshima discloses a double-faced heat-peelable pressure sensitive adhesive (psa) sheet that contains a substrate, a heat-peelable psa layer (containing microspheres that are heat-expandable) directly attached on one side of the

Art Unit: 1712

substrate and a pressure sensitive adhesive layer that is present on the other side of the substrate. (See *also*, Oshima, paragraphs [0011] to [0013] for content of heat-peelable psa layer) In paragraphs [0033] to [0034], Oshima further discloses adding an intermediate release layer (or a coating layer with release agent) between the substrate and the heat-expandable layer, thus "improving the peelability from an adherend after heating." Accordingly, Oshima does disclose that the substrate and the heat-peelable layer containing the heat-expandable microspheres "are peelable from each other by heating."

Moreover, the instant specification teaches that the claimed heat-peelable double-faced psa sheet "may have other layers in appropriate positions according to need, ... such other layers disposed between layers ... may be of one kind or of two or more kinds." (Specification, page 39, lines 5-15) The specification further teaches including a coating interlayer between the substrate and the heat-peelable layer to impart releasability; a coating layer for improving adhesion; a layer for increasing the area of adhesion to adherends; and a layer for improving adhesive force (e.g., a psa layer). (Specification, page 39, line 16 to page 40, line 7)

Thus, the embodiment of the psa sheet disclosed in Figure 2 of Oshima, when considered in view of the teachings of the instant specification, anticipates the invention encompassed by the instant claims because both sets of psa sheets can contain multiple heat-peelable layers and psa layers on one or more sides of the substrate or adherend.

Finally, in response to Applicant's arguments that Dobson does not expressly disclose various physical properties discussed in Response, it is noted that the features upon which applicant relies (e.g., silicon wafer grindability and peelability) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, although Oshima may not explicitly disclose these physical properties for the disclosed heat-peelable psa sheet, because the psa sheet disclosed in Oshima and that encompassed by the instant claims are the same heat-peelable psa sheet, then both sets of adhesive sheets must inherently possess the same physical properties/effects, such as grindability and peelability upon use.

Thus, the instant claims remain anticipated by Oshima.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1712

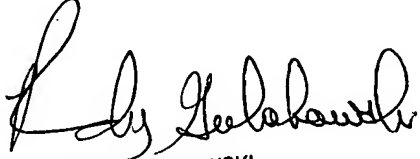
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



RANDY GULAKOWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700